



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/421,055	04/12/1995	MICHAEL A. JOHNSON	49286USA9C	5806

7590

11/19/2002

JAMES V. LILLY, ESQUIRE
3M OFFICE OF INTELLECTUAL
PROPERTY COUNSEL
P O BOX 33427
ST PAUL, MN 551333427

EXAMINER

GALLAGHER, JOHN J

ART UNIT

PAPER NUMBER

1733

29

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/421051

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4X IQ JURY 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 6-32 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 6-32 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit 1733

1. Claims 14-15 and 30 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons as set forth in paragraph 4 of the last Office action (viz. section (c) (i.e. lines 7-13) and also section (b) in the last two lines, of this paragraph).

2. The rejection of claims 6-32 under the judicial doctrine of obviousness type double patenting is hereby reiterated for the reasons as set forth in paragraph 6 of the last Office action; further along this line, the "two way" test for patentability is seen to be NOT applicable in the instant case, since, while the instant invention and that of George et al. may be related (on their respective faces) as genus-species, the two inventions are seen to be completely different i.e. the invention of George et al. is seen to be a new invention relative to the instant invention, there being no apparent evidence that the later filed invention is or was ever even intended or envisioned as being an IMPROVEMENT over the instant invention i.e. the invention of George et al. is apparently not (i.e. nowhere disclosed or indicated as being envisioned as) an IMPROVEMENT over the invention set forth in the instant application, which foregoing constitutes a necessary criterion or requirement for the application of this NARROW EXCEPTION to the general rule of the "one way" test viz. the "two way" test, as set forth in all of Borah, Braat and Berg.

Art Unit 1733

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-8, 14-16, 20-26 and 29-32 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al.

5. Claims 12-13 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further taken in combination with Pletcher.

6. Claims 9 and 28 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further taken in combination with Schappert et al.

7. Claims 17-19 and 27 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinzer et al. taken in combination with either Harrison et al. or Smith et al., and further taken in combination with Kan.

Art Unit 1733

8. Applicants' arguments filed 24 January 2002 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 9-12 of the last Office action), with the following being noted and/or additionally advanced: (a) Applicants' contentions and arguments with respect to the word "topography" are seen to have merit; however, since this word (by applicants' own dictionary excerpt submission) defines the features of a surface (i.e. of an object) viz. a featured SURFACE, the word "surface" in line 7 of claim 6 is therefore seen to be redundant; and (b) for applications filed BEFORE 29 November 1999, prior art applicable only under 35 U.S.C. § 102(e) is NOT disqualified, precluded or prohibited from being properly applicable under the provisions of 35 U.S.C. § 103(c) i.e. N.B. MPEP § 706.02(1), second paragraph.

9. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS

Art Unit 1733

OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) ⁸⁷⁶⁻⁹³¹¹~~305-3599~~.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJG
JJGallagher:cdc
November 4, 2002


JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 181 / 733